



PATENT
Docket No. 2026-4269US1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Rong-Fu Wang et al.
Serial No. : 09/529,206 Group Art Unit: 1642
Filed : June 13, 2000 Examiner: Davis, Natalie A.
For : NOVEL HUMAN CANCER ANTIGEN ESO-1/CAG-3 AND GENE
ENCODING SAME

RESPONSE TO RESTRICTION REQUIREMENT
UNDER 35 U.S.C. §121 and 372

COMMISSIONER OF PATENTS
Washington, D.C. 20231

Sir:

The following is a response to the Restriction Requirement dated December 10, 2001.

The Examiner has grouped the claims into eleven separate and distinct inventions as follows:

Group I. Claims 1-30, drawn to cancer peptides, pharmaceutical compositions, and immunogens.

Group II. Claims 31-46, 48, 50-51, and 65, drawn to nucleic acids, vectors, host organisms, oligos, recombinant viruses, method of making a protein, and pharmaceutical compositions.

Group III. Claims 47 and 49, drawn to an antibody.

Group IV. Claims 52-54, drawn to a method of detecting cancer or precancer using mRNA.

Group V. Claim 55, drawn to a method of detecting a CAG-3 genomic nucleic acid sequence.

Group VI. Claim 56, drawn to a method of detecting a cancer peptide.

Group VII. Claims 57, 60, and 62, drawn to a method of preventing or inhibiting cancer by administering a cancer peptide.

Group VIII. Claims 58 and 61, drawn to a method of inhibiting melanoma in vitro by administering cancer peptide specific T lymphocytes.

Group IX. Claim 59, drawn to a method of detecting cancer using a protein and antibody.

Group X. Claim 63, drawn to a method of preventing or inhibiting cancer by administering the recombinant virus of claim 43.

Group XI. Claims 64, and 66-67, drawn to a cancer antigen.

With all due respect, applicants disagree that the Examiner's requirement is proper. However, in order to facilitate prosecution and to avoid a holding of non-responsiveness, applicants elect the claims of Group I, Species C with traverse.

Restriction of Group I into Species A-V is improper. Applicants have elected Group I, Species C. This species is a short protein sequence containing 180 amino acids.

Species F, G, H, I, J, M, N, O, P, Q, R, S, and T are all peptide sequences within the protein sequence of Species C (SEQ ID NO:4). Applicants respectfully request that these species be examined together, because applicant's election of SEQ ID NO:4 (Species C) automatically requires the Examiner to search these other species as they are part of SEQ ID NO:

4. There are no additional searches necessary to examine these species. It is not burdensome for the Examiner to examine the species related to SEQ ID NO: 4 together with SEQ ID NO: 4. But rather it is burdensome on applicants, to require separate filings to prosecute amino acid sequences, which are all part of the amino acid sequence of SEQ ID NO:4. Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

In addition, applicants respectfully disagree with the remaining species categories. SEQ ID NO: 51 (Species E) is a DNA fragment of SEQ ID NO: 3 (Species B), which, in turn, represents a DNA fragment of SEQ ID NO:2 (Species A), which, in turn, is a DNA fragment of SEQ ID NO: 1. These sequences should be examined together. Further, SEQ ID NO: 46 (Species L and U) and SEQ ID NO: 47 (Species K and V) are peptide fragments of SEQ ID NO: 5 (Species D) and should all be examined together. Therefore, applicants generally object to the species groupings of the restriction requirement and respectfully request reconsideration and withdrawal thereof.

In the event that the Examiner does not withdraw the requirement, applicants expressly reserve the right to file a divisional application to the presently non-elected subject matter.

Applicants respectfully request reconsideration and withdrawal or at a minimum modification of the requirement (37 C.F.R. §1.143).

Early and favorable action by the Examiner is earnestly solicited.

If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned at (212) 415-8564. The undersigned may also be contacted by e-mail at drauth@morganfinnegan.com.

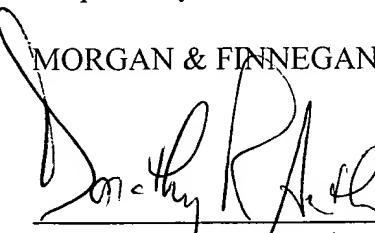
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 2026-4269US1. A DUPLICATE OF THIS SHEET IS ATTACHED

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

By:


Dorothy R. Auth
Registration No. 36,434

Date: February 4, 2002

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